

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-7 are now in the application. Claims 1 and 5 have been amended. Claims 6-7 have been added.

In item 3 on pages 2-5 of the above-mentioned Office action, claims 1-5 have been rejected as being unpatentable over Hummel et al. (US Pat. No. 5,823,109) under 35 U.S.C. § 103(a). Applicants assume that claims 1-5 are rejected as being unpatentable over Hummel et al. in view of Greiner et al. (US Pat. No. 4,397,236), because the reference Greiner et al. is mentioned in this item.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references. However, the language of claims 1 and 5 has been amended to even more clearly define the invention of the instant application.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 5 call for, inter alia:

a first distributor roller and a second distributor roller, said first distributor roller being in rolling contact simultaneously with two ink applicator rollers and being disposed more closely to the printing form than said second distributor roller, said first distributor roller axially oscillating more slowly than said second distributor roller.

It is described in column 3, lines 30-34 and 53-54 of Hummel et al. (referred to by the Examiner on page 3, line 10 of the Office action) that the first roller 22, which is disposed more closely to the printing form than the second roller 20, has a smaller peripheral speed (not axial speed) than the second roller 20. Assuming that the rollers 20 and 22 in Hummel et al. would be assigned to the oscillating mechanism of Greiner et al. as suggested by the Examiner (see the second paragraph on page 4 of the Office action), the combination would not necessarily lead to the conclusion that the roller 22 axially oscillates more slowly than the second roller 20 and would not necessarily reach the invention of the instant application. Greiner et al. only disclose that the roller in the oscillating mechanism axially oscillates faster with increasing peripheral speed and axially oscillates more slowly with decreasing peripheral speed due to the structure of the oscillating mechanism. The so-called proportionality between the peripheral speed and the axial frequency in Greiner et al. exists only to one and the same roller. As already discussed in the response (see page 4 thereof) to the previous office

action dated March 17, 2003, with regard to the relationship between axial frequencies of different rollers, Greiner et al. consider exactly the opposite of the invention of the instant application as being advantageous.

The Examiner has stated in the paragraph bridging pages 4 and 5 of the Office action that applying further teachings of Greiner et al. is unnecessary. Applicants respectfully disagree. It is noted that an individual aspect should not be allowed to be taken out of direct context. An individual aspect should be considered together with the teachings from the context as a whole.

In addition, the Examiner has also stated that the limitation "being axially oscillatable more slowly" in claim 1 is merely a recitation of the intended use of the distributor rollers and does not result in a structural difference between the claimed invention and any prior art (see the third paragraph on page 4 of the Office action). However, it is noted that a functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*,

439 F.2d 210, 169 USPQ 226 (CCPA 1971). A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. See MPEP 2173.05(g).

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 and 5. Claims 1 and 5 are, therefore, believed to be patentable over the art and since all of the dependent claims are dependent on claim 1, they are believed to be patentable as well.

Claims 6-7 have been added. The support for claims 6-7 can be found, for example, on page 8, line 21, of the specification of the instant application. Since claims 6-7 are dependent on claims 1 or 5, which are believed to be patentable as discussed above, they are believed to be patentable as well.

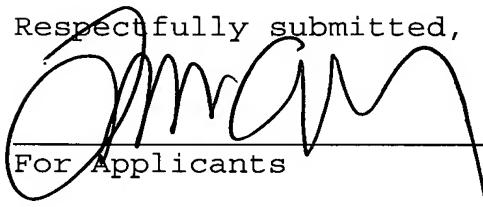
In view of the foregoing, reconsideration and allowance of claims 1-7 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate a telephone call so that, if possible, patentable language can be worked out.

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In the alternative, the entry of the amendment is requested as it is believed to place the application in better condition for appeal, without requiring extension of the field of search.

If an extension of time for this paper is required, petition for extension is herewith made. Please charge any fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,

For Applicants

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